103

6-12-04

Attorney's Docket No. 11087-004001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Examiner: Justin Foster
BAUM et al.	Art Unit: 2624
Application No.: 09/436,704	
Filed: 11/9/1999	
For: Distributing Images to Multiple Recipients	**APPELLANT'S BRIEF ON APPEAL**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313

On May 27 2004

By: _____

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Brief is presented in support of the Notice of Appeal filed on January 27, 2004, from the final rejection of Claims 1-155 of the above-identified application, as set forth in the Final Office Action mailed October 28, 2003.

Please deduct the requisite small entity fee, pursuant to 37 C.F.R. § 1.17(c), to Deposit Account 501861, and deduct any additional fees or credit any excess fees associated with the Appeal Brief to such deposit account. An original and two copies of the Brief are enclosed herewith. Appendix A, attached hereto, contains a copy of all claims pending in this case.

REAL PARTY OF INTEREST

The Real Party of Interest is Shutterfly Inc., a Delaware corporation.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

STATUS OF CLAIMS

Claims 1-155 are pending and are the subject of this Appeal. All claims have been rejected. Claims 1-155 are the subject of this appeal. No other claims are pending.

STATUS OF AMENDMENTS

An Initial Office Action mailed 9/11/03 objected to informality in the Specification. Further, claims 1-8, 12-13, 30-42, 44-48, 57-58, 80-87, 91-92, 107-115 and 132 were rejected under Section 103(a) as unpatentable over Fredlund (5,666,215) and Johnson (6,052,670). Claims 9-11 and 88-90 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, and Shiota (6,324,521). Claims 14 and 93 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Tackbary (5,555,496). Claims 15-25, 27-28, 94-102 and 104-105 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok (6,157,436). Claims 26 and 103 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota. Claim 29 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Clark (4,854,094). Claim 43 was rejected under Section 103(a)

as unpatentable over Fredlund, Johnson and Stancato (5,056,823). Claims 49-51 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Tackbary. Claims 52-53 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Brewen (4,872,706). Claims 54-56 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Stancato. Claims 59-61, 71-75 and 77-78 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Claim 62 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Klees (5,652,936). Claims 63-65 and 69 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Claims 66-68 and 76 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota. Claim 70 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Tackbary. Claim 79 and 106 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Clark. Claims 116-119 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Shiota. Claim 120 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Shiota and Clark. Claims 121-126 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Shiota and Cok. Claims 127, 130 and 131 were rejected under Section 103(a) as unpatentable over Fredlund, Klees and Shiota. Claims 128-129 were rejected under Section 103(a) as unpatentable over Fredlund, Klees, Shiota and Ohtsuka (EPO 98118497.1). Claims 133-146 were rejected under Section 103(a) as unpatentable over Fredlund and Cok. Claims 147-153 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Finally, claims 154-155 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota.

Appellants filed a Response on October 1, 2003 traversing the Section 103 rejections. In a Final Office Action mailed on October 28, 2003, the same rejections were reiterated. Appellants amended some of the claims and traversed the rejections on January 27, 2004. A Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences, under 37 C.F.R. § 1.191, was also filed on January 27, 2004. An Advisory Action was mailed on February 12, 2004 indicating that the proposed amendments were not entered as they are not deemed to place the application in better form for appeal. An Appellant's Brief on Appeal is mailed herewith.

SUMMARY OF THE INVENTION

Briefly, in one aspect, Appellant's invention relates to a computer-implemented method of distributing image prints to a plurality of recipients (including, e.g., an individual, a business entity, and/or an address) may include receiving an order specifying a plurality of recipients (e.g., where at least one of the specified recipients is different from a user from whom the order was received) and, for each specified recipient, a set of one or more images associated with that recipient. The method also may include, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set and distributing the printed image copies to their respective associated recipients.

In another aspect, a computer-implemented method of distributing physical manifestations of digital content to a plurality of recipients may include receiving an order specifying a plurality of recipients and, for each specified recipient, a set of digital content (e.g., one or more digital images) associated with that recipient. The method may also include for each of the plurality of recipients specified in the received order, generating a physical manifestation of the digital content in the recipient's digital content set, and distributing the physical manifestations to their respective associated recipients. The physical manifestation of the digital content may include photographic prints of the one or more digital images, framed photographic prints, photo-album pages bearing one or more digital images, compositions of digital images and other graphical and/or textual content, and/or artifacts bearing a digital image such as a novelty item, a shirt, a coffee mug, a key-chain, a mouse pad, a magnet, or a deck of playing cards.

In another aspect, a computer-implemented method of distributing photographic prints to a plurality of recipients may include receiving an order specifying (i) a plurality of recipients, (ii) for each specified recipient, a set of one or more digital images associated with that recipient, and (iii) for each digital image, a set of one or more print parameters (e.g., print size, number of copies, print finish, and/or a textual message). The method also may include dividing the received order into a plurality of sub-orders so that each sub-order corresponds to a different specified recipient and includes an instance of each digital image associated with the recipient corresponding to the sub-order. The method further may include printing the instantiated digital

images in each of the sub-orders according to the print parameters associated with each image, and distributing the prints to their respective associated recipients. The order may be received by receiving interactive input from a user of a computer system (e.g., the user's personal computer system or a public entry terminal).

In another aspect, a method of distributing photographic prints to users may include receiving from a user a computer-readable medium bearing one or more digital images, processing the one or more digital images to generate one or more photographic prints, storing computer software on the computer-readable medium received from the user, and sending the one or more photographic prints and the computer-readable medium storing computer software to the user.

In another aspect, a print distribution system may include a front-end computer sub-system for receiving an order specifying a plurality of recipients (including, e.g., an individual, a business entity, and/or an address) and, for each specified recipient, a set of one or more images associated with that recipient. The system also may include a printing sub-system for printing at least one copy of each image in each recipient's image set, and a distribution sub-system for distributing the printed image copies to their respective associated recipients. At least one of the specified recipients may be different from a user from whom the order was received.

In another aspect, a method of facilitating print re-orders includes receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient The method also may include, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set and printing a re-order number on a back of each image copy. The re-order number may uniquely identify the image, the recipient of that image, and/or the originator of that image. The method also may include distributing the printed image copies to their respective associated recipients, receiving input (e.g., using an automatic voice or touchtone response system) from a recipient specifying a print re-order number and/or one or more print parameters associated with the print re-order, generating a print of the image associated with the print re-order number, and sending the print to the recipient associated with the print re-order number. Furthermore, the order may include a single transaction sequence such as a single charge to a

financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button.

In another aspect, a computer-implemented method of distributing image prints to a plurality of recipients may include receiving, at a facility corresponding to a first entity (e.g., a photo-finishing enterprise), an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. The method also may include communicating the received order to a facility corresponding to a second entity (e.g., a goods / service provider enterprise such as a supermarket, a drugstore, a post office, or an online grocer). The method further may include, at the second entity's facility, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set, and distributing the printed image copies to their respective associated recipients. Distributing the printed image copies may include delivering a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient.

In another aspect, a computer-implemented method of distributing image prints to a plurality of recipients may include receiving an order from a user at a public entry terminal (e.g., a digital drop box, a point-of-sale station, or a kiosk), the order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. The method also may include transmitting the received order from the public entry terminal to a photo-finishing facility. The method further may include printing, for each of the plurality of recipients specified in the received order, at the photo-finishing facility at least one copy of each image in the recipient's image set and distributing the printed image copies to their respective associated recipients.

In another aspect, a computer-implemented method of ordering image prints for a plurality of recipients may include receiving at a host system an order from a client system, where the order includes a single transaction sequence and specifies a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. The method further may include, at the host system, dividing the received order into a plurality of sub-orders, where each sub-order corresponds to a different recipient. The method also may include printing a set of one or more images in each sub-order and/or printing, for each sub-

order, a run of prints associated with a specified recipient. Moreover, the method may include printing a destination identifier that identifies the specified recipient for a corresponding run of prints. The destination identifier may delimit a corresponding sub-order and/or may include one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information.

In another aspect, a computer-implement method of processing an order for a physical manifestation of digital content may include receiving an order specifying a plurality of recipients and, for each specified recipient, a set of digital content associated with that recipient. The method also may include dividing the received order into a plurality of sub-orders (each sub-order corresponding to a different recipient) by instantiating a digital copy of the digital content for each recipient designated to receive a physical manifestation of that digital content. The method further may include generating a physical manifestation of the digital content in the recipient's digital content set. The digital content may include a digital image and the physical manifestation may include a photographic print of the digital image.

One or more of the following advantages may be provided. The systems and techniques provide intuitive and convenient mechanisms that allow a user to order prints of images and have the prints distributed to multiple recipients at different locations with a minimum of time, trouble and expense on the part of the ordering user. For example, in a single ordering sequence, a user can specify a set of one or more prints and have them distributed to multiple different recipients. As a result, the user need not reenter redundant information – for example, identifying the images to be printed, supplying payment information, and the like – as otherwise would be required if the print order was limited to a single shipping destination. Moreover, by allowing a user to specify multiple recipients within a single print order, the user is not subjected to a minimum dollar amount for each of several different orders. Rather, because multiple recipients are allowed, the user is better able to satisfy the minimum dollar amount without being forced to order more prints than otherwise would be desired.

In addition, because an order can designate multiple recipients, the user need not incur multiple charges on a credit card or other financial instrument when ordering prints for multiple recipients. Furthermore, by allowing the user to specify different print parameters (e.g., size,

number of copies, finish) for each of the individual recipients, flexibility and convenience in the print ordering process are enhanced.

Moreover, users can distribute copies of prints to multiple recipients without having to incur the effort and expense involved in receiving print copies from a photofinisher, sorting the prints into sets according to destinations, putting the prints in protective envelopes, and then re-mailing the sets of prints to their respective recipients. As a result, sets of prints can be distributed to multiple destinations more quickly and with less expense and effort.

In addition, by employing a non-linear workflow model certain benefits and efficiencies are realized. More particularly, by taking a single multiple-recipient order, breaking it down into sub-orders corresponding to a single recipient, selectively instantiating and re-organizing multiple instances of designated images to build each sub-order, and then printing each sub-order as a separate run of prints for the associated recipient, a single print order (transaction sequence) can be used to order prints to be generated and distributed to multiple recipients. Moreover, such a non-linear workflow tends to increase the efficiency and/or speed of the print generation and distribution tasks dramatically.

ISSUES PRESENTED FOR REVIEW

I. Whether claims 1-8, 12-13, 30-42, 44-48, 57-58, 80-87, 91-92, 107-115 and 132 are unpatentable under Section 103(a) over Fredlund (5,666,215) and Johnson (6,052,670).

II. Whether claims 9-11 and 88-90 are unpatentable under Section 103(a) over Fredlund, Johnson, and Shiota (6,324,521).

III. Whether claims 14 and 93 are unpatentable under Section 103(a) over Fredlund, Johnson and Tackbary (5,555,496).

IV. Whether claims 15-25, 27-28, 94-102 and 104-105 are unpatentable under Section 103(a) over Fredlund, Johnson and Cok (6,157,436).

V. Whether claims 26 and 103 are unpatentable under Section 103(a) over Fredlund, Johnson, Cok and Shiota.

VI. Whether claim 29 is unpatentable under Section 103(a) over Fredlund, Johnson, Cok and Clark (4,854,094).

VII. Whether claim 43 is unpatentable under Section 103(a) over Fredlund, Johnson and Stancato (5,056,823).

VIII. Whether claims 49-51 are unpatentable under Section 103(a) over Fredlund, Johnson and Tackbary.

IX. Whether claims 52-53 are unpatentable under Section 103(a) over Fredlund, Johnson and Brewen (4,872,706).

X. Whether claims 54-56 are unpatentable under Section 103(a) over Fredlund, Johnson and Stancato.

XI. Whether claims 59-61, 71-75 and 77-78 are unpatentable under Section 103(a) over Fredlund, Johnson and Cok.

XII. Whether claim 62 is unpatentable under Section 103(a) over Fredlund, Johnson, Cok and Klees (5,652,936).

XIII. Whether claims 63-65 and 69 are unpatentable under Section 103(a) over Fredlund, Johnson and Cok.

XIV. Whether claims 66-68 and 76 are unpatentable under Section 103(a) over Fredlund, Johnson, Cok and Shiota.

XV. Whether claim 70 is unpatentable under Section 103(a) over Fredlund, Johnson, Cok and Tackbary.

XVI. Whether claims 79 and 106 are unpatentable under Section 103(a) over Fredlund, Johnson, Cok and Clark.

XVII. Whether claims 116-119 are unpatentable under Section 103(a) over Fredlund, Johnson and Shiota.

XVIII. Whether claim 120 is unpatentable under Section 103(a) over Fredlund, Johnson, Shiota and Clark.

XIX. Whether claims 121-126 are unpatentable under Section 103(a) over Fredlund, Johnson, Shiota and Cok.

XX. Whether claims 127, 130 and 131 are unpatentable under Section 103(a) over Fredlund, Johnson, Klees and Shiota.

XXI. Whether claims 128-129 as unpatentable under Section 103(a) over Fredlund, Johnson, Klees, Shiota and Ohtsuka (EPO 98118497.1).

XXII. Whether claims 133-146 as unpatentable under Section 103(a) over Fredlund, Johnson and Cok.

XXIII. Whether claims 147-153 as unpatentable under Section 103(a) over Fredlund, Johnson and Cok.

XXIV. Whether claims 154-155 as unpatentable under Section 103(a) over Fredlund, Johnson, Cok and Shiota.

GROUPING OF CLAIMS

For each ground of rejection that appellant contest herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

ARGUMENT

All claims have been rejected as unpatentable over the prior art. A quick review of the requirement for a *prima facie* case of obviousness is helpful. Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.
>
> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

Appellants respectfully traverse the rejection of claims 1-155 as unpatentable since neither the patents cited in the Final Office Action, nor any other evidence of record establish a *prima facie* case of obviousness of claims 1-155.

I. CLAIMS 1-8, 12-13, 30-42, 44-48, 57-58, 80-87, 91-92, 107-115 AND 132 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND AND JOHNSON

Claims 1-8, 12-13, 30-42, 44-48, 57-58, 80-87, 91-92, 107-115 and 132 were rejected under Section 103(a) as unpatentable over Fredlund (5,666,215) and Johnson (6,052,670). Fredlund shows a system where a photographic image can be viewed at a customer's location on her personal computer and images selected for initial printing, reprinting and ordering related image services. The Office Action noted that:

> The difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that 'each order may have multiple ship addresses and multiple order items'. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient.

Appellant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Johnson et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Appellant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Appellant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

Appellant traverses the comparison. Here, Johnson shows an object oriented framework mechanism for an electronic catalog. The electronic catalog framework includes core classes and

extensible classes that allow a framework consumer to implement a desired electronic catalog. As discussed on Col. 17, lines 16-49, the electronic catalog allows users to select from a common list of products to all customers.

> Referring to FIG. 9, an example of electronic catalog framework 870 (FIG. 8) in accordance with the preferred embodiment performs steps that comprise a method 900 for defining an electronic catalog. The first step is to setup the components that are needed to define and use the desired electronic catalog (step 910). This step builds and maintains critical objects in the electronic catalog, such as product objects, the catalog object, order objects, and customer objects. Once one or more catalogs are defined and ready to use, a customer may interact with the electronic catalog to browse for product information and to place an order. To start using an electronic catalog, a user typically selects the desired catalog (step 920). For an on-line catalog, this selection may be made by the user clicking a link that identifies which catalog to use. Next, the customer may enter information that identifies the customer to the electronic catalog (step 930). This information may include a user password or authorization code if use of the catalog is restricted to authorized users. The electronic catalog then validates the customer information, if required (step 940). If the customer is authorized to access the electronic catalog, the catalog cover is then displayed to the user (step 950). The cover page may include advertisements for special sales items, or any other appropriate information that needs to be conveyed to a user. The cover page will typically include a link that will open the catalog (step 960) when selected by a user. Once the catalog has been opened, the catalog may process any user request that is supported by the catalog (step 970). Examples of some suitable user requests are: finding a product; jumping to a catalog index; jumping to a listing of the contents of the catalog; jumping to a table of contents; and creating a pick list. Once the pick list is complete, the user may submit the pick list to create an order (step 980).

However, this shopping modality is different that that for photo printing, where each image is unique. Each user uploads images in his or her account. The images in each user's account are completely personalized to the user. An electronic catalog that can be viewed and selected by all users does not simply exist in photo printing in the instant application. Applying Johnson's teaching to Fredlund would not have resulted in an operable system since there is no common list of products/services such as those found in a catalog.

A catalog is geared to selling standardized products that can be catalogued. In contrast, in the photography field, each image product is unique and individualized. The concept of a catalog selling custom/individualized images in single quantity is inapposite. Hence, Fredlund

does not allow a user to order for multiple recipients at different addresses in one order wherein each recipient can receive different photo products in such an order. Similarly, Johnson's electronic catalog does not describe such method of submitting one order having different recipients wherein each recipient receives different products. One skilled in the art would not have combined a catalog system such as Johnson catalog with the Fredlund system to provide uniquely individualized photo products as in the claimed invention.

The evidence shows that the reference used to reject the claims teaches away from the claimed invention since the proposed combination of an electronic catalog with Fredlund would render the construction of the references impracticable for their intended purposes and the combination would be uneconomical and unreliable. This teaching away is a per se demonstration of lack of *prima facie* obviousness. The teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction. In re Fine, 873 F.2d 1021 (Fed. Cir. 1988). Despite this evidence, the Final Office Action maintained that the combination is proper as the Johnson reference is only used to apply the narrow teaching that it is known in the prior art for a single order to specify a plurality of recipients and order items.

The rebuttal evidence also shows that there is no basis in the art for combining the references in the manner proposed. Per MPEP Section 2143.01:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
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> In *In re Kotzab*, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one system may be used to control a number of valves. The court found that there was insufficient evidence to show that one system was the same as one sensor. While the control of multiple valves by a single sensor rather than by multiple sensors was a "technologically simple concept," there was

> no finding "as to the specific understanding or principle within the knowledge of the skilled artisan" that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.
>
> In *In re Fine*, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed.

The instant case is similar to *In re Fine* in that the Office Action asserted that it would have been within the skill of the art to substitute a catalog for standardized products with a system in the primary reference to order personalized image prints. In this case, there was no support or explanation of this conclusion and the rejection should be withdrawn.

The rebuttal evidence also noted that the combination of references proposed in the Final Office Action would render the construction of the references impracticable for their intended purposes. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, there is no motivation to combine.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed,

there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The evidence also indicates that there was no reasonable expectation of success when combining the Johnson catalog for standardized products with the Fredlund unique image system. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (Claims directed to a method for the commercial scale production of polyesters in the presence of a solvent at superatmospheric pressure were rejected as obvious over a reference which taught the claimed method at atmospheric pressure in view of a reference which taught the claimed process except for the presence of a solvent. The court reversed, finding there was no reasonable expectation that a process combining the prior art steps could be successfully scaled up in view of unchallenged evidence showing that the prior art processes individually could not be commercially scaled up successfully.). *See also Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 USPQ2d 1016, 1022-23 (Fed. Cir.), cert. denied, 502 U.S. 856 (1991) (In the context of a biotechnology case, testimony supported the conclusion that the references did not show that there was a reasonable expectation of success.); *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).

Appellants have provided evidence pointing away from obviousness and in accordance with MPEP Section 2143.01:

> If the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the Appellant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a

> preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not.
>
> When an Appellant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the Appellant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

The combination suggested in the office action was done using selective hindsight. There is simply no suggestion or motivation in Johnson to modify Fredlund to arrive at a computer-implemented method of distributing image prints to a plurality of recipients by receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipient.

Appellant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Appellant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claim 1 of a single order with multiple recipients. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art, for a single order specifying a plurality of recipients, *prima facie* obviousness of claim 1 (and dependent claims) has not been established.

Additionally, the claims were rejected through improper use of hindsight. Such unsupported rejections are improper and must be withdrawn. The use of hindsight was acknowledged in the Final Office Action:

Applicant argues that the combination of Fredlund and Johnson is invalid since Johnson discloses a framework for an electronic catalog with standardized products, whereas Fredlund discloses a system for ordering personalized image prints. Applicant argues that one skilled in the art would not have combined these references since the resulting combination would not have resulted in an operable system since there is no common list of products/services in the Fredlund reference as there is in the Johnson reference. However, the Johnson reference is only used to apply the narrow teaching, found in lines 60-62 of column 22, that it is known in the prior art for a single order to specify a plurality of recipients and order items. As this is the only claimed element lacking from Fredlund, the Examiner maintains that the combination is proper.

Applicant argues that the combination of Fredlund and Johnson was done using selective hindsight and that there was no suggestion or motivation in Johnson to modify Fredlund. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170.

Such unsupported use of hindsight and improper combination are improper. Moreover, each dependent claim was rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" without specific support.

As such, it is respectfully requested that the § 103(a) rejection of independent claims (and dependent claims) be withdrawn and the claims be allowed.

II. CLAIMS 9-11 AND 88-90 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, AND SHIOTA (6,324,521).

In rejecting claims 9-11 and corresponding claims 88-90, the Final Office Action noted that:

> Claims 9-11 and 88-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Shiota, et al. (6,324,521). With regard to claim 9, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund in view of Johnson does not disclose the method wherein the functions of receiving, printing and distributing among two or more different entities. Shiota teaches, in lines 65 of column 1 through 9 of column 2, a method of distributing image prints wherein a center server receives an order for image prints and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the functions of receiving, printing, and distributing of Fredlund and Johnson to be dispersed among two or more different entities as taught by Shiota. This would provide a prompt service to a customer because each entity could be tailored to a specific task.
>
> With regard to claim 10, Fredlund in view of Johnson discloses the invention as stated in claim 1. Fredlund in view of Johnson does not disclose the receiving of an order by an enterprise providing a web front-end. Shiota teaches, in lines 21-32 of column 2, the use of a website on the Internet through which an order is transferred from a customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive an order by an enterprise providing a web front-end. This would allow for the order to be automatically received in the correct predetermined data format.
>
> With regard to claim 11, Fredlund in view of Johnson in further view of Shiota discloses the invention as stated in claim 10. Shiota further discloses, in lines 65 of column 1 through 9 of column 2, the method of distributing image prints wherein a center server receives a "printing service order via the network" using a web front end as described in lines 21-32 of column 2, and a separate laboratory server prints and distributes the ordered prints. It would have been obvious to one of ordinary skill in the art at the time the invention was made for printing or distributing, or both, to be performed by a fulfillment enterprise different than the enterprise providing the web front-end. This would provide a prompt service to a customer.

Shiota relates to a network photograph service system which can provide a prompt service to a customer without losing the advantage of a network photograph service system such as easy of use/access and collective data management. The Office Action noted that Shiota's center server receives an order for image prints and a separate lab server prints and distributes the ordered prints and that it would have been obvious to receive/divide/print/distribute to be dispersed among two or more different entities.

However, the entities referred to in the claims are business partners that are in the chain of making and delivering the pictures to the customers. For example, as discussed at the bottom of page 4 of the Specification, the dividing the received order into the plurality of sub-orders may be performed by a first entity (e.g., a photo-finishing enterprise) and printing the sub-orders may be performed by a second entity (e.g., a goods / service provider enterprise such as a supermarket, a drugstore, a post office, or an online grocer). Shiota does not show such plurality of entities. At best Shiota's entities are lab servers, each of which stand-alone and each of which receive/divide/print/distribute prints. As a result, Shiota fails to disclose the claimed entities in the chain of making and delivering prints to the user.

Further, Appellant notes that references can not be arbitrarily combined. There must be some reason why one skilled in the art would be motivated to make the proposed combination of the references. *In re Nomiya*, 184 U.S.P.Q. 607 (CCPA 1975). Here, as discussed above, there is no suggestion to combine Johnson with Fredlund. In addition, there is no suggestion to combine Shiota with Johnson and Fredlund.

As to claims 9 and 88, besides a conclusory statement using hindsight provided by the teaching of the instant case that the combination "would provide a prompt service to a customer because each entity could be tailored to a specific task", the Office Action has not pointed to <u>any</u> evidence in Shiota or Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipients, wherein the receiving, printing and distributing is dispersed among two or more different entities. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

As to claims 10 and 89, besides using hindsight taught by the instant Specification, the Office Action has not pointed to any evidence in Shiota or Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipients, wherein receiving an order is performed by an enterprise providing a web front-end.

As to claims 11 and 90, besides using hindsight taught by the instant Specification, the Office Action has not pointed to any evidence in Shiota or Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipients, wherein printing or distributing, or both, are performed by a fulfillment enterprise different than the enterprise providing the web front-end.

Moreover, the combination of references proposed in the Office Action would render the construction of the references impracticable for their intended purposes as combining Shiota with Johnson and Fredlund would arrive at an electronic catalog system for receiving photo orders and for printing at various minilabs and special labs. Additionally, Shiota taught away from the proposed combination in that it would be uneconomical and unreliable. The proposed combination would not have been expected by those skilled in the art to be successful. There was no motivation or suggestion in the art as of the filing date of the instant case that would have prompted one skilled in the art to make the combination. Withdrawal of the rejection on claims 9-11 and 88-90 is requested.

III. CLAIMS 14 AND 93 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND TACKBARY (5,555,496)

Again, the Examiner has not pointed to any evidence in Tackbary, Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipients, where printing and distributing are performed by different entities. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the references, or knowledge of those skilled in the art, for a single order specifying a plurality of recipients, *prima facie* obviousness of claims 14 and 93 has not been established. In this case, the rejections rely on hindsight gained by applying the teaching of the instant Application against its claims. Withdrawal of the rejection on claims 14 and 93 is requested.

IV. CLAIMS 15-25, 27-28, 94-102 AND 104-105 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND COK (6,157,436).

The Office Action noted that "Fredlund in view of Johnson does not disclose dividing the received order into a plurality of sub-orders. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient. This would allow for each recipient's order to be prepared separately which ensures that each order is delivered to the proper recipient." Again, hindsight using the teaching of the instant specification has been used.

The Examiner failed to show any evidence in Cok, Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed receiving an order specifying a plurality of recipients and, for each specified

recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipients; and prior to printing, dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art to modify Fredlund to arrive at receiving a single order specifying a plurality of recipients and dividing the order into a plurality of sub-orders, each corresponding to a different recipient, *prima facie* obviousness of claims 15-25, 27-28, 94-102 and 104-105 has not been established. Moreover, the dependent claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

V. CLAIMS 26 AND 103 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, COK AND SHIOTA.

Claims 26 and 103 depend from allowable claims, and therefore each is allowable. Moreover, the Office Action fails to show any evidence in Cok, Shiota, Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention wherein "the first entity comprises a photo-finishing enterprise". See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson, Cok or Shiota reference, or knowledge of those skilled in the art, for a first entity being a photo-finishing enterprise, *prima facie* obviousness of claims 26 and 103 has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

VI. CLAIM 29 IS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, COK AND CLARK (4,854,094).

The Office Action stated that "Fredlund in view of Johnson in further view of Cok does not disclose shipping unrelated goods along with a recipient's printed image copies. Clark teaches, in lines 6-8 of column 8, a method of shipping unrelated goods along with a previously established order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to deliver a recipient's printed image copies along with an unrelated order of goods/services associated with that recipient. This would reduce the total shipping cost."

Clark relates to a method for converting one or more steel shipping containers into a habitable building at a building site and the product thereof . There is absolutely no relationship between Clark and the claimed invention, as Clark shows mounting at least one standard steel shipping container on a weight-bearing foundation at the ends thereof. Where two or more containers are used, the containers may be in spaced and/or abutting side-by-side relationship; and/or may be mounted one upon another. The cited Col. 8 merely shows that the containers can be used to ship to the building site the additional parts for upgrading the building. Additional space in the container can be used to ship other, unrelated goods, thereby reducing the cost of the container to the builder. Also, where several novel buildings are to be built at the same location, one or more containers can be used temporarily as the builders office and/or warehouse for parts while the novel buildings are being built. There is no basis to combine the Clark steel shipping containers with Fredlund, Johnson, and Cok.

Claim 29 depends from allowable claims, and therefore it is allowable. Moreover, the Office Action fails to show <u>any</u> evidence in Cok, Shiota, Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the invention recited in claim 29. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the cited references, or knowledge of those skilled in the art for *prima facie* obviousness of claim 29 has not been established. Moreover, the claims were rejected with the conclusory statement

"It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

VII. CLAIM 43 IS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND STANCATO (5,056,823).

The Office Action asserted "Fredlund in view of Johnson does not disclose the set of digital content comprising photo-album pages. Stancato teaches, in lines 6-15 of column 1, the use of a photo-album for displaying images. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise photo-album pages bearing one or more digital images. This would achieve an overall aesthetically appealing display of the images."

Stancato relates to a design associated with the fabrication and construction of a prebound album wherein the individual pages of the album are selectively interchangeable, each particular page evidencing a new and unique method of fabrication and construction capable or having mounted thereon a photograph or other item for display purposes so as to achieve an overall aesthetically appearing album design. However, there is nothing in Stancato that relates to a physical manifestation of digital content as photo-album pages bearing one or more digital images.

Claim 43 depends from allowable claims, and therefore it is allowable. Moreover, the Office Action fails to show any evidence in Stancato, Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the references, or knowledge of those skilled in the art, *prima facie* obviousness of claim 43 has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

VIII. CLAIMS 49-51 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND TACKBARY.

The Office Action noted that

> Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Tackbary. With regard to claim 49, Fredlund in view of Johnson discloses the invention as stated in claim 48. Fredlund in view of Johnson does not disclose wherein the physical manifestation of the set of digital content comprises cards bearing the graphical and/or textual content. Tackbary teaches, in lines 25-40 of column 9, the selection of cards bearing graphical or textual content. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the physical manifestation of the set of digital content to comprise cards bearing the graphical and/or textual content. This would allow the user to send images in the form of cards, which are considered a socially important way to keep in touch.

Claims 49-51 depend from allowable claims, and therefore it is allowable. Moreover, the Office Action fails to show any evidence in Tackbary, Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson and Tackbary reference, or knowledge of those skilled in the art, for *prima facie* obviousness of claim 49-51 has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

IX. CLAIMS 52-53 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND BREWEN (4,872,706).

Claims 52-53 depend from allowable claims, and therefore it is allowable. Moreover, the Office Action fails to show any evidence in Brewen and Johnson or how knowledge of those

skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson and Tackbary reference, or knowledge of those skilled in the art, for *prima facie* obviousness of the claims has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

X. CLAIMS 54-56 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND STANCATO.

Claims 52-53 depend from allowable claims, and therefore it is allowable. Moreover, the Office Action fails to show any evidence in Stancato and Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the reference, or knowledge of those skilled in the art, for *prima facie* obviousness of the claims has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

XI. CLAIMS 59-61, 71-75 AND 77-78 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND COK.

Claims 59-61, 71-75, 77 and 78 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok. With regard to claim 59, the Office Action noted:

> Fredlund discloses a computer-implemented method of distributing photographic prints to a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection of

a set of one or more images to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. Fredlund further discloses, in lines 45 of column 4 through 6 of column 6, the setting of one or more print parameters. One difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for a single received order to specify a plurality of recipients, and for each specified recipient, a set of one or more images associated with that recipient. This would streamline the order process. Fredlund also does not disclose dividing the received order into a plurality of sub-orders. Cok teaches, in lines 60 of column 2 through 2 of column 3, the dividing of an order for image prints into multiple sub-orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the received order into a plurality of sub-orders, each sub-order corresponding to a different specified recipient, each suborder comprising an instance of each digital image associated with the recipient corresponding to the sub-order. This would allow for each recipient's order to be prepared separately. Fredlund further discloses, in lines 18-30 of column 7, a step of filling the order by printing the selected images. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the instantiated digital images in each of the sub-orders according to the print parameters associated with each image. This step is necessary in order to complete the order.

As discussed above, Johnson cannot be combined with Fredlund because it is a catalog of standard items and customers do not use a catalog system to order their pictures. The combination would not work at any rate. Moreover, the Office Action fails to show <u>any</u> evidence in Johnson, Cox or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention of the independent claim 59:

A computer-implemented method of distributing photographic prints to a plurality of recipients, the method comprising:

(a) receiving an order specifying:

(i) a plurality of recipients;

(ii) for each specified recipient, a set of one or more digital images associated with that recipient; and

(iii) for each digital image, a set of one or more print parameters;

(b) dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different specified recipient, each sub-order comprising an instance of each digital image associated with the recipient corresponding to the sub-order;

(c) printing the instantiated digital images in each of the sub-orders according to the print parameters associated with each image; and

(d) distributing the prints to their respective associated recipients

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the reference, or knowledge of those skilled in the art, for *prima facie* obviousness of the claims has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reasons created from hindsight. Such unsupported rejections are improper and must be withdrawn.

XII. CLAIM 62 IS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, COK AND KLEES (5,652,936).

The Office Action asserted that

> Klees teaches, in lines 30-45 of column 2, the use of an "automatic photofinishing apparatus", which is inherently a public entry terminal, for submitting photographic print orders. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the computer system to comprise a public entry terminal. This would allow for users without personal computers to utilize the service.

First, claim 62 is patentable since it depends from allowable claims. The hindsight used by the Office Action was incorrect. Klees relates to workstation for interaction of a customer at

the apparatus thereby providing instructions to the customer for ordering processing of an undeveloped photosensitive material. The workstation includes a first display device for providing instructions and information to the customer for use in said apparatus, for entering data responsive to said instructions; an acceptance device for receiving image data; a printing mechanism for issuing a customer claim check having a unique identification indica; and a second display visually separate from the workstation for displaying the status of various customer orders.

Moreover, the Office Action fails to show any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to result in a computer-implemented method of distributing photographic prints to a plurality of recipients, the method comprising:

(a) receiving an order specifying:

(iv) a plurality of recipients;

(v) for each specified recipient, a set of one or more digital images associated with that recipient; and

(vi) for each digital image, a set of one or more print parameters;

(b) dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different specified recipient, each sub-order comprising an instance of each digital image associated with the recipient corresponding to the sub-order;

(c) printing the instantiated digital images in each of the sub-orders according to the print parameters associated with each image; and

(d) distributing the prints to their respective associated recipients, wherein receiving an order comprises receiving interactive input from a user of a computer system and wherein the computer system is a public terminal. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the reference, or knowledge of those skilled in the art, for *prima facie* obviousness of the claims has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made"

with reasons created using hindsight. Such unsupported rejections are improper and must be withdrawn.

XIII. CLAIMS 63-65 AND 69 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND COK.

The Office Action rejected claims 63-65 and 69 under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Cok. With regard to claim 63, Fredlund in view of Johnson in further view of Cok discloses the invention as stated in claim 59. Fredlund further discloses several types of print parameters that can be modified for an image. Lines 35 of column 5 disclose the options of setting print size and quantity. Lines 63-66 of column 5 disclose the setting of red eye reduction, which is a type of print finish. Line 5 of column 5 discloses the option to add text to the image.

Claims 63-65 and 69 are patentable since they depend from allowable claims. The claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn. In this case, the Office Action fails to show any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the reference, or knowledge of those skilled in the art, for *prima facie* obviousness of the claims has not been established.

XIV. CLAIMS 66-68 AND 76 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, COK AND SHIOTA.

The Office Action noted that Shiota's center server receives an order for image prints and a separate lab server prints and distributes the ordered prints and that it would have been obvious to receive/divide/print/distribute to be dispersed among two or more different entities.

However, the entities referred to in the claims are business partners that are in the chain of making and delivering the pictures to the customers. For example, the dividing the received order into the plurality of sub-orders may be performed by a first entity (e.g., a photo-finishing enterprise) and printing the sub-orders may be performed by a second entity (e.g., a goods / service provider enterprise such as a supermarket, a drugstore, a post office, or an online grocer). Shiota does not show such plurality of entities. At best Shiota's entities are lab servers, each of which stand-alone.

For the above reasons, claims 66-68 and 76 are patentable in addition to the fact that they depend from allowable claims. Moreover, the Office Action fails to show any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. As discussed above, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

XV. CLAIM 70 IS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, COK AND TACKBARY.

The Office Action notes that Tackbary teaches the use of a card distribution center and the delivery of cards via a different entity. As discussed above, the Office Action fails to show any evidence in Johnson, Cok, Tackbary or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. Withdrawal of the rejection is requested.

XVI. CLAIMS 79 AND 106 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, COK AND CLARK.

The Office Action used Clark to show the distributing the prints comprises delivering a recipient's prints along with an unrelated order of goods / services associated with that recipient. However, as discussed above, Clark relates to a steel shipping container. The claims were

rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. One skilled in the art would not have combined a steel shipping container to mail images. Such unsupported rejections are improper and must be withdrawn.

XVII. CLAIMS 116-119 ARE PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND SHIOTA.

Again, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

More over, as discussed above, there is no suggestion to combine, and Fredlund, Johnson and Shiota, singly or in combination, fail to show the claimed computer-implemented method of distributing image prints to a plurality of recipients by receiving, at a facility corresponding to a first entity, an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; communicating the received order to a facility corresponding to a second entity; at the second entity's facility, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipients.

Withdrawal of the rejection is requested.

XVIII. Claim 120 is patentable under Section 103(a) over Fredlund, Johnson, Shiota and Clark.

As discussed above, as discussed above, Clark relates to a steel shipping container. The claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. One skilled in the art would not have combined a steel shipping container to mail images. Further, the claims were rejected with the conclusory statement "It would have been obvious to

one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

XIX. Claims 121-126 are patentable under Section 103(a) over Fredlund, Johnson, Shiota and Cok.

As discussed above, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such hind-sight supported rejections are improper and must be withdrawn.

XX. Claims 127, 130 and 131 are patentable under Section 103(a) over Fredlund, Johnson, Klees and Shiota.

The rejection improperly used the teachings of the instant invention to reconstruct the claims using the references. A clear example of the use of hindsight and inherency to reconstruct piecemeal the invention is shown in the rejection of claim 127, 130 and 131 as follows:

> Claims 127, 130 and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Johnson in further view of Klees in further view of Shiota. With regard to claim 127, Fredlund discloses a computer-implemented method of distributing image prints to a plurality of recipients. Fredlund discloses, in lines 38-47 of column 5, the selection of a set of one or more images to be ordered. Fredlund further discloses, in lines 30-33 of column 6, the use of a "done" button which completes the order for a particular image and recipient address but lets the user place another order with respect to another image and another recipient address before payment information is entered. Fredlund further states, in lines 36-37 of column 6, the possibility of sending the same image to different addresses. One difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that "each order may have multiple ship addresses and multiple order items". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient. Fredlund further discloses, in lines 18-30 of column 7, a step of

filling the order by printing the selected images at the photofinisher, which is inherently a photo-finishing facility. This is inherently printing at the photo-finishing facility at least one copy of each image in the recipient's image set for each of the plurality of recipients specified in the received order. Fredlund further discloses, in lines 42-44 of column 2, the step of distributing the printed image copies to their respective associated recipients. Fredlund does not disclose the receiving of an order from a public entry terminal and transmitting the received order from the public entry terminal to a photo-finishing facility. Klees teaches, in lines 30-45 of column 2, the use of an "automatic photofinishing apparatus", which is inherently a public entry terminal, for submitting photographic print orders. Shiota teaches, in lines 45-62 of column 7, the method of receiving images at a minilab and transmitting the images to a center server, which is a photo-finishing lab. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund such that an an order could be submitted from a user at a public entry terminal, such as the "automatic photofinishing apparatus" of Klees and transmitted from the public entry terminal to a photo-finishing lab in accordance with Shiota. Allowing users to submit orders via a public entry terminal, as taught by Klees, would provide access to the print ordering service of Fredlund and Johnson for customers without their own personal computers to place orders from. 130. With regard to claim 130, Fredlund in view of Johnson in further view of Klees in further view of Shiota discloses the invention as stated in claim 127. Klees further teaches, in lines 3035 of column 2, "a touch screen video display 14 (for example, a CRT) for displaying customer order instructions and for entering customer order data by the customer". It would have been obvious to one of ordinary skill in the art at the time the invention was made for the public entry terminal to comprise a method of receiving manual input specifying the plurality of recipients and the set of one or more images associated with each recipient in order for the user to input his order.

There is no showing that the references suggest a combination that shows receiving an order from a user at a public entry terminal, the order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. Johnson would not work because it is for catalogs, and one skilled in the art would not combine a catalog framework for picture ordering because the catalog is for standard items while pictures are individually unique and not suitable for distribution through a catalog system.

As discussed above, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reasons from using hindsight. Such unsupported rejections are improper and must be withdrawn.

XXI. CLAIMS 128-129 AS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, KLEES, SHIOTA AND OHTSUKA (EPO 98118497.1).

These claims are allowable since they depend from allowable claims. Moreover, as discussed above, there is no suggestion to combine Fredlunk, Johnson, Klees and Shiota. Now, there is also no suggestion to combine Ohtsuka. The claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

XXII. CLAIMS 133-146 AS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND COK.

These claims are allowable since they depend from allowable claims. Moreover, as discussed above, there is no suggestion to combine Fredlund, Johnson and Cok. Further, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

XXIII. CLAIMS 147-153 AS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON AND COK.

These claims are allowable since they depend from allowable claims. Moreover, as discussed above, there is no suggestion to combine Fredlund, Johnson and Cok. Further, s discussed above, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

XXIV. CLAIMS 154-155 AS PATENTABLE UNDER SECTION 103(A) OVER FREDLUND, JOHNSON, COK AND SHIOTA.

These claims are allowable since they depend from allowable claims. Moreover, as discussed above, there is no suggestion to combine Fredlund, Johnson, Cok and Shiota. Further, as discussed above, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

SUMMARY

For the foregoing reasons, it is earnestly submitted that the Examiner's rejection is erroneous, that reversal of this decision is respectfully requested, and that all of the pending claims be allowed.

Respectfully submitted,

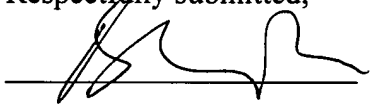

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EXHIBIT A

PENDING CLAIMS

1. A computer-implemented method of distributing image prints to a plurality of recipients, the method comprising:

receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient;

for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and

distributing the printed image copies to their respective associated recipients.

2. The method of claim 1 wherein images in a first recipient's image set differ from images in a second recipient's image set.

3. The method of claim 1 wherein print parameters of a first recipient's image set differ from printing parameters of a second recipient's image set.

4. The method of claim 3 wherein print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

5. The method of claim 1 wherein print parameters differ among images within an image set.

6. The method of claim 5 wherein print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

7. The method of claim 1 wherein each image set comprises an arbitrary grouping of images designated by a user.

8. The method of claim 1 wherein receiving, printing and distributing are performed by a single entity.

9. The method of claim 1 wherein the performance of receiving, printing and distributing is dispersed among two or more different entities.

10. The method of claim 1 wherein receiving an order is performed by an enterprise providing a web front-end.

11. The method of claim 10 wherein printing or distributing, or both, are performed by a fulfillment enterprise different than the enterprise providing the web front-end.

12. The method of claim 1 wherein printing and distributing are integrated processes.

13. The method of claim 1 wherein printing and distributing are performed by a single entity.

14. The method of claim 1 wherein printing and distributing are performed by different entities.

15. The method of claim 1 further comprising, prior to printing, dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient.

16. The method of claim 15 wherein printing comprises printing a set of one or more images in each sub-order.

17. The method of claim 15 wherein printing comprises, for each sub-order, printing a run of prints associated with a specified recipient.

18. The method of claim 17 further comprising printing a destination identifier that identifies the specified recipient for a corresponding run of prints.

19. The method of claim 18 wherein the destination identifier delimits a corresponding sub-order.

20. The method of claim 18 wherein printing the destination identifier comprises printing one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information.

21. The method of claim 18 wherein a first image in a sub-order has one or more print parameters that differ from one or more print parameters of a second image in the sub-order.

22. The method of claim 21 wherein print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

23. The method of claim 15 wherein dividing the received order into the plurality of sub-orders comprises, for each image in the received order, instantiating a copy of the image for each recipient designated to receive a print of that image.

24. The method of claim 23 wherein an instantiated copy comprises a digital image file.

25. The method of claim 15 wherein dividing the received order into the plurality of sub-orders is performed by a first entity and printing the sub-orders is performed by a second entity.

26. The method of claim 25 wherein the first entity comprises a photo-finishing enterprise.

27. The method of claim 25 wherein the second entity comprises a goods / service provider enterprise.

28. The method of claim 25 wherein the second entity comprises a supermarket, a drugstore, a post office, or an online grocer.

29. The method of claim 25 wherein distributing the printed image copies comprises delivering a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient.

30. The method of claim 1 wherein a recipient comprises an individual.

31. The method of claim 1 wherein a recipient comprises a business entity.

32. The method of claim 1 wherein a recipient comprises an address.

33. The method of claim 1 wherein the plurality of recipients comprises an individual, an address, a business entity, or any combination thereof.

34. The method of claim 1 wherein at least one of the specified recipients is different from a user from whom the order was received.

35. The method of claim 1 wherein the order comprises a single transaction sequence.

36. The method of claim 35 wherein the single transaction sequence comprises a single charge to a financial instrument.

37. The method of claim 36 wherein the financial instrument comprises a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon.

38. The method of claim 35 wherein the single transaction sequence is terminated by a click of an "order" button.

39. A computer-implemented method of distributing physical manifestations of digital content to a plurality of recipients, the method comprising:

receiving an order specifying a plurality of recipients and, for each specified recipient, a set of digital content associated with that recipient;

for each of the plurality of recipients specified in the received order, generating a physical manifestation of the digital content in the recipient's digital content set; and

distributing the physical manifestations to their respective associated recipients.

40. The method of claim 39 wherein a set of digital content comprises one or more digital images.

41. The method of claim 40 wherein the physical manifestation of the set of digital content comprises photographic prints of the one or more digital images.

42. The method of claim 39 wherein the physical manifestation of digital content comprises a framed photographic print of a digital image.

43. The method of claim 39 wherein the physical manifestation of the set of digital content comprises photo-album pages bearing one or more digital images.

44. The method of claim 39 wherein the physical manifestation of the set of digital content comprises compositions of digital images and other graphical and/or textual content.

45. The method of claim 40 wherein the physical manifestation of the set of digital content comprises an artifact bearing a digital image.

46. The method of claim 45 wherein the artifact bearing a digital image comprises a novelty item.

47. The method of claim 45 wherein the artifact bearing the digital image comprises a shirt, a coffee mug, a key-chain, a mouse pad, a magnet, or a deck of playing cards.

48. The method of claim 39 wherein a set of digital content comprises graphical and/or textual content.

49. The method of claim 48 wherein the physical manifestation of the set of digital content comprises cards bearing the graphical and/or textual content.

50. The method of claim 49 wherein the cards bearing the graphical and/or textual content comprise one or more of the following: greeting cards, holiday cards, announcements, playing cards, post cards, thank you cards, or invitations.

51. The method of claim 48 wherein the physical manifestation of the set of digital content comprises cards bearing the graphical and/or textual content.

52. The method of claim 48 wherein the physical manifestation of the set of digital content comprises advertisements bearing the graphical and/or textual content.

53. The method of claim 48 wherein the physical manifestation of the set of digital content comprises coupons bearing the graphical and/or textual content.

54. The method of claim 48 wherein the physical manifestation of the set of digital content comprises a bound volume bearing the graphical and/or textual content.

55. The method of claim 54 wherein the bound volume comprises a photo-album.

56. The method of claim 54 wherein the bound volume comprises a travel book.

57. The method of claim 48 wherein the graphical and/or textual content comprises digital images and/or digitized content.

58. The method of claim 48 wherein the graphical and/or textual content comprises computer-generated content.

59. A computer-implemented method of distributing photographic prints to a plurality of recipients, the method comprising:

(a) receiving an order specifying:

(vii) a plurality of recipients;

(viii) for each specified recipient, a set of one or more digital images associated with that recipient; and

(ix) for each digital image, a set of one or more print parameters;

(b) dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different specified recipient, each sub-order comprising an instance of each digital image associated with the recipient corresponding to the sub-order;

(c) printing the instantiated digital images in each of the sub-orders according to the print parameters associated with each image; and

(d) distributing the prints to their respective associated recipients.

60. The method of claim 59 wherein receiving an order comprises receiving interactive input from a user of a computer system.

61. The method of claim 60 wherein the computer system comprises the user's personal computer system.

62. The method of claim 60 wherein the computer system comprises a public entry terminal.

63. The method of claim 59 wherein the print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

64. The method of claim 59 wherein printing and distributing are integrated processes.

65. The method of claim 59 wherein receiving, dividing, printing and distributing are performed by a single entity.

66. The method of claim 59 wherein the performance of receiving, dividing, printing and distributing is dispersed among two or more different entities.

67. The method of claim 59 wherein receiving an order is performed by an enterprise providing a web front-end.

68. The method of claim 67 wherein one or more of dividing, printing and distributing are performed by a fulfillment enterprise different than the enterprise providing the web front-end.

69. The method of claim 59 wherein printing and distributing are performed by a single entity.

70. The method of claim 59 wherein printing and distributing are performed by different entities.

71. The method of claim 59 further comprising printing a destination identifier that identifies the specified recipient for a corresponding sub-order.

72. The method of claim 71 wherein the destination identifier delimits a corresponding sub-order.

73. The method of claim 71 wherein printing the destination identifier comprises printing one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information.

74. The method of claim 59 wherein a first image in a sub-order has print parameters that differ from print parameters of a second image in the sub-order.

75. The method of claim 59 wherein dividing the received order into the plurality of sub-orders is performed by a first entity and printing the sub-orders is performed by a second entity.

76. The method of claim 75 wherein the first entity comprises a photo-finishing enterprise.

77. The method of claim 75 wherein the second entity comprises a goods / service provider enterprise.

78. The method of claim 77 wherein the second entity comprises a supermarket, a drugstore, a post office, or an online grocer.

79. The method of claim 59 wherein distributing the prints comprises delivering a recipient's prints along with an unrelated order of goods / services associated with that recipient

80. A print distribution system comprising:

a front-end computer sub-system for receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient;

a printing sub-system for printing at least one copy of each image in each recipient's image set; and

a distribution sub-system for distributing the printed image copies to their respective associated recipients.

81. The system of claim 80 wherein images in a first recipient's image set differ from images in a second recipient's image set.

82. The system of claim 80 wherein print parameters of a first recipient's image set differ from printing parameters of a second recipient's image set.

83. The system of claim 82 wherein print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

84. The system of claim 80 wherein print parameters differ among images within an image set.

85. The system of claim 84 wherein print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

86. The system of claim 80 wherein each image set comprises an arbitrary grouping of images designated by a user that placed the order.

87. The system of claim 80 wherein the front-end computer sub-system, the printing sub-system and the distribution sub-system are controlled by a single entity.

88. The system of claim 80 wherein the front-end computer sub-system, the printing sub-system, and the distribution sub-system are dispersed among two or more different entities.

89. The system of claim 80 wherein the front-end computer sub-system is controlled by an enterprise providing a web front-end.

90. The system of claim 89 wherein the printing sub-system or the distribution sub-system, or both, are controlled by a fulfillment enterprise different than the enterprise providing the web front-end.

91. The system of claim 80 wherein the printing sub-system and the distribution sub-system are integrated.

92. The system of claim 80 wherein the printing sub-system and the distribution sub-system are controlled by a same entity.

93. The system of claim 80 wherein the printing sub-system and the distribution sub-system are controlled by different entities.

94. The system of claim 80 wherein the printing sub-system comprises a sub-system for dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient.

95. The system of claim 94 wherein the printing sub-system prints a set of one or more images in each sub-order.

96. The system of claim 94 wherein, for each sub-order, the printing sub-system prints a run of prints associated with a specified recipient.

97. The system of claim 96 wherein the printing sub-system further prints a destination identifier that identifies the specified recipient for a corresponding run of prints.

98. The system of claim 97 wherein the destination identifier delimits a corresponding sub-order.

99. The system of claim 97 wherein printing the destination identifier comprises printing one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information.

100. The system of claim 94 wherein dividing the received order into the plurality of sub-orders comprises, for each image in the received order, instantiating a copy of the image for each recipient designated to receive a print of that image.

101. The system of claim 100 wherein an instantiated copy comprises a digital image file.

102. The system of claim 94 wherein dividing the received order into the plurality of sub-orders is performed by a first entity and printing the sub-orders is performed by a second entity.

103. The system of claim 102 wherein the first entity comprises a photo-finishing enterprise.

104. The system of claim 102 wherein the second entity comprises a goods / service provider enterprise.

105. The system of claim 104 wherein the second entity comprises a supermarket, a drugstore, a post office, or an online grocer.

106. The system of claim 104 wherein distributing the printed image copies comprises delivering a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient.

107. The system of claim 80 wherein a recipient comprises an individual.

108. The system of claim 80 wherein a recipient comprises a business entity.

109. The system of claim 80 wherein a recipient comprises an address.

110. The system of claim 80 wherein the plurality of recipients comprises an individual, an address, a business entity, or any combination thereof.

111. The system of claim 80 wherein at least one of the specified recipients is different from a user from whom the order was received.

112. The system of claim 80 wherein the order received by the front-end computer system comprises a single transaction sequence.

113. The system of claim 112 wherein the single transaction sequence comprises a single charge to a financial instrument.

114. The system of claim 113 wherein the financial instrument comprises a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon.

115. The system of claim 112 wherein the single transaction sequence is terminated by a click of an "order" button

116. A computer-implemented method of distributing image prints to a plurality of recipients, the method comprising:

receiving, at a facility corresponding to a first entity, an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient;

communicating the received order to a facility corresponding to a second entity;

at the second entity's facility, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and

distributing the printed image copies to their respective associated recipients.

117. The method of claim 116 wherein the first entity comprises a photo-finishing enterprise.

118. The method of claim 116 wherein the second entity comprises a goods / service provider enterprise.

119. The method of claim 118 wherein the second entity comprises a supermarket, a drugstore, a post office, or an online grocer.

120. The method of claim 118 wherein distributing the printed image copies comprises delivering a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient.

121. The method of claim 116 wherein, prior to communicating the received order to the facility corresponding to the second entity, the first entity divides the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient.

122. The method of claim 121 wherein printing comprises printing a set of one or more images in each sub-order.

123. The method of claim 121 wherein printing comprises, for each sub-order, printing a run of prints associated with a specified recipient.

124. The method of claim 123 further comprising printing a destination identifier that identifies the specified recipient for a corresponding run of prints.

125. The method of claim 124 wherein the destination identifier delimits a corresponding sub-order.

126. The method of claim 124 wherein printing the destination identifier comprises printing one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information.

127. A computer-implemented method of distributing image prints to a plurality of recipients, the method comprising:

receiving an order from a user at a public entry terminal, the order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient;

transmitting the received order from the public entry terminal to a photo-finishing facility;

for each of the plurality of recipients specified in the received order, printing at the photo-finishing facility at least one copy of each image in the recipient's image set; and

distributing the printed image copies to their respective associated recipients.

128. The method of claim 127 wherein receiving the order from the user at the public entry terminal comprises reading digital images from a computer-readable medium provided to the public-entry terminal.

129. The method of claim 128 wherein the computer-readable medium comprises a FLASH memory, a CD-ROM or a diskette.

130. The method of claim 127 wherein receiving the order from the user at the public entry terminal comprises receiving manual input specifying the plurality of recipients and the set of one or more images associated with each recipient.

131. The method of claim 127 wherein the public entry terminal comprises a digital drop box, a point-of-sale station, or a kiosk.

132. A computer-implemented method of ordering image prints for a plurality of recipients, the method comprising receiving at a host system an order from a client system, the order corresponding to a single transaction sequence and specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient.

133. The method of claim 132 further comprising, at the host system, dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient.

134. The method of claim 133 further comprising printing a set of one or more images in each sub-order.

135. The method of claim 133 wherein further comprising, for each sub-order, printing a run of prints associated with a specified recipient.

136. The method of claim 135 further comprising printing a destination identifier that identifies the specified recipient for a corresponding run of prints.

137. The method of claim 136 wherein the destination identifier delimits a corresponding sub-order.

138. The method of claim 136 wherein printing the destination identifier comprises printing one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information.

139. The method of claim 133 wherein a first image in a sub-order has print parameters that differ from print parameters of a second image in the sub-order.

140. The method of claim 139 wherein print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

141. The method of claim 133 wherein dividing the received order into the plurality of sub-orders comprises, for each image in the received order, instantiating a copy of the image for each recipient designated to receive a print of that image.

142. The method of claim 141 wherein an instantiated copy comprises a digital image file.

143. The method of claim 132 wherein images in a first recipient's image set differ from images in a second recipient's image set.

144. The method of claim 132 wherein print parameters of a first recipient's image set differ from printing parameters of a second recipient's image set.

145. The method of claim 144 wherein print parameters include one or more of print size, number of copies, print finish, and/or a textual message.

146. The method of claim 132 wherein print parameters differ among images within an image set.

147. A computer-implemented method of processing an order for a physical manifestation of digital content, the method comprising:

receiving an order specifying a plurality of recipients and, for each specified recipient, a set of digital content associated with that recipient;

dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient, by instantiating a digital copy of the digital content for each recipient designated to receive a physical manifestation of that digital content; and

generating a physical manifestation of the digital content in the recipient's digital content set.

148. The method of claim 147 wherein the digital content comprises a digital image and the physical manifestation comprises a photographic print of the digital image.

149. The method of claim 147 further comprising distributing the physical manifestations to their respective associated recipients.

150. The method of claim 147 wherein the receiving and dividing are performed by a first entity and the generating is performed by a second entity.

151. The method of claim 150 wherein the first entity comprises a photo-finishing enterprise and the second entity comprises a goods / service-provider enterprise.

152. The method of claim 147 wherein receiving, dividing and generating are performed by a single entity.

153. The method of claim 147 wherein the performance of receiving, dividing and generating is dispersed among two or more different entities.

154. The method of claim 147 wherein receiving an order is performed by an enterprise providing a web front-end.

155. The method of claim 154 wherein dividing or generating, or both, are performed by a fulfillment enterprise different than the enterprise providing the web front-end.